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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,622	10/24/2003	Jerome O. Vogedes	33692.03.3156	8796

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EXAMINER

KHAN, SUHAIL

ART UNIT PAPER NUMBER

2686

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/692,622	VOGEDES ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Suhail Khan	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                 |                                                                                        |
|-------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/10/2003</u> . | 6) <input type="checkbox"/> Other: ____                                                |

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 6-21 have been renumbered 5-20. Newly renumbered claims 6-8 now depend on newly renumbered claim 5. Newly renumbered claims 10-13 now depend on newly renumbered claim 9. Newly renumbered claims 15-18 now depend on claim 14. Newly renumbered claim 19 now depends on claim 18.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-9, 11-14, 16-21 and 23-24 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent App. No. 2004/0198471 to Deeds.

Referring to claim 1, Deeds discloses an apparatus for sender controllable modalities (complete system in figure 1), the apparatus comprising: a priority command generator (page 3, paragraph 30, controller is interpreted as being the priority command generator) capable of

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generating a priority command that includes a modality alert command (page 5, paragraph 42, user is able to prioritize events based on ring tones; ring tones are interpreted as being modality alert commands); a communication command generator capable of generating a communication command (page 4, paragraph 33, on pressing SEND key user initiates communication); and a transmitter (page 3, paragraph 30, transmitter) operably coupled to the priority command generator and the communication command generator such that the priority command and the communication command are transmitted to a recipient device wherein the recipient device may receive the modality alert command within the priority command (page 5, paragraph 42, user sets preferences on mobile station, mobile station receives signals that are prioritized by ring tones).

Referring to claim 2, Deeds discloses an apparatus of claim 1 further comprising: an input device operably coupled to the communication command generator such that the communication command generator generates the communication command in response to an input communication command (page 4, paragraph 33, keypad).

Referring to claim 3, Deeds discloses the apparatus of claim 2 further comprising: the input device operable coupled to the priority command generator such that the priority command generator generates the modality alert in response to an input priority command (page 4, paragraph 33, keypad).

Referring to claim 4, Deeds discloses the apparatus of claim 1 wherein the modality alert command includes instructions such that an alert is at least one of the following: a vibration, a predetermined ring tone, one or more beeps, one or more flashing lights, a wake-up command and a defined output multi-modal output modality setting (page 5, paragraph 42, ring tones).

Referring to claim 5, Deeds discloses an apparatus for sender controllable modalities, the apparatus comprising: a notification system having an internal alert modality setting (page 5, paragraph 42, program); a receiver operably coupled to the notification system (col 3, paragraph 30, receiver), wherein the receiver receives a communication command and a priority command from a sender device (page 3, paragraph 30, receiver); a verification module operably coupled to the receiver such that the verification module verifies the sender device and the priority command so that if the sender device is verified and the priority command is verified, a modality alert command is provided to the notification system to override the internal modality setting (page 5, paragraph 40, Identification; page 5, paragraph 42, program), wherein the modality alert command is disposed within a notification command (page 5, paragraph 42, ring tones) and a notification device operably coupled to the notification system such that in response to the notification command, the notification device provides an alert in accordance with the modality alert command (page 3, paragraph 32, speaker generates ring tone).

Referring to claim 7, Deeds discloses the apparatus of claim 5 wherein the modality alert command includes instructions such that the alert is at least one of the following: a vibration, a predetermined ring tone, one or more beeps, one or more flashing lights, a wake-up command and a defined output multi-modal output modality setting (page 5, paragraph 42, ring tones).

Referring to claim 8, Deeds discloses the apparatus of claim 5 wherein the verification module further includes a memory device (page 4, paragraph 36, memory) storing a plurality of sender device identifiers and the internal modality setting such that the verification module verifies that the sender device may override the internal modality setting based on a comparison

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of the sender device with the plurality of sender device identifiers (page 5, paragraph 40, Identification).

Referring to claim 9, Deeds discloses a method for sender controllable modalities in a sender device, the method comprising: generating a communication command (page 4, paragraph 33, on pressing SEND key user initiates communication); generating a priority command including a modality alert command, wherein the priority command relates to the communication command; and transmitting the communication command and the priority command to a recipient device (page 5, paragraph 42, user sets preferences on mobile station, mobile station receives signals that are prioritized by ring tones).

Referring to claim 11, Deeds discloses the method of claim 9 wherein the modality alert command includes at least one of the following: a vibratory alert a ring-tone, a wake-up command, a text-based alert an illumination alert and a defined output multi-modal output modality setting (page 5, paragraph 42, program the ring tones).

Referring to claim 12, Deeds discloses the method of claim 9 wherein the communication command may be at least one of the following: a caller identification, a text message, an auditory message and a visual message (page 5, paragraph 42, ring tones).

Referring to claim 13, Deeds discloses the method of claim 9 wherein the step of transmitting the communication command and the priority command to the recipient device further includes transmitting the communication command and the priority command to an intermediate server prior to the communication command and the priority command being transmitted to the recipient device (page 5, paragraph 46, server).

Referring to claim 14, Deeds discloses a method for sender controllable modalities in a recipient device the method comprising: receiving a communication command and a priority command from a sender device (page 5, paragraph 42, user is able to prioritize events based on ring tones; ring tones are interpreted as being modality alert commands); verifying the sender device such that the sender device may override an internal modality setting (page 5, paragraph 40, Identification); if the sender device is verified, verifying the priority command such that the priority command has a priority level to override the internal modality setting; and if the sender device is verified and the priority command is verified, overriding the internal modality setting (page 5, paragraph 42, program).

Referring to claim 16, Deeds discloses the method of claim 14 wherein the modality alert command includes at least one of the following: a vibratory alert, a ring-tone, a wake-up command, a text-based alert, an illumination alert and a defined output multi-modal output modality setting (page 5, paragraph 42, program the ring tones).

Referring to claim 17, Deeds discloses the method of claim 14 wherein the communication command may be at least one of the following: a caller identification, a text message, an auditory message and a visual message (page 5, paragraph 42, ring tones).

Referring to claim 18, Deeds discloses the method of claim 14 wherein the step of receiving the communication command and the priority command from the sender device further includes receiving the communication command and the priority command to from intermediate server wherein the intermediate server receives the communication command and the priority command from the sender device (page 5, paragraph 46, server).

Referring to claim 19, Deeds discloses the method of claim 18 wherein the step of verifying the sender device may be performed on the intermediate server and the step of verifying the priority command may be performed on the intermediate server (page 5, paragraph 46, server).

Referring to claim 20, Deeds discloses a system for sender controllable modalities (complete system in figure 1), the system comprising; a sending device including: a priority command generator capable of generating a priority command that includes a modality alert command (page 3, paragraph 30, controller is interpreted as being the priority command generator); a communication command generator capable of generating a communication command (page 4, paragraph 33, on pressing SEND key user initiates communication); and a transmitter operably coupled to the priority command generator and the communication command generator such that the priority command and the communication command are transmitted to a recipient device wherein the recipient device may receive the modality alert command within the priority command; and the recipient device including (page 3, paragraph 30, transmitter); a notification system having an internal alert modality setting; a receiver operably coupled to the notification system, wherein the receiver receives the communication command and the priority command from a sender device (col 3, paragraph 30, receiver); a verification module operably coupled to the receiver such that the verification module verifies the sender device and the priority command so that if the sender device is verified and the priority command is verified (page 5, paragraph 40, Identification), a modality alert command is provided to the notification system to override the internal modality setting (page 5, paragraph 42, program), wherein the modality alert command is disposed within a notification command;



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and a notification device operably coupled to the notification system such that in response to the notification command, the notification device provides an alert in accordance with the modality alert command (page 3, paragraph 32, speaker generates ring tone).

Referring to claim 21, Deeds discloses the system of claim 20 wherein the sender device further includes an input device operably coupled to the communication command generator such that the communication command generator generates the communication command in response to an input communication command and the input device operable coupled to the priority command generator such that the priority command generator generates the modality alert in response to an input priority command (page 4, paragraph 33, keypad).

Referring to claim 23, Deeds discloses the system of claim 20 wherein the communication command includes a multi-modal message such that the internal modality setting provides for an output display of the communication command and the modality alert command includes instructions for adjusting the form of output display for the communication command (page 3, paragraph 32, display).

Referring to claim 24, Deeds discloses the system of claim 20 wherein the modality alert command includes instructions such that the alert is at least one of the following: a vibration, a predetermined ring tone, one or more beeps, one or more flashing lights, a wake-up command and a defined multi-modal output modality setting (page 5, paragraph 42, program the ring tones).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 10, 15 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent App. No. 2004/0198471 to Deeds, in view of U.S. Patent No. 6867733 to Sandhu et al.

Referring to claims 6 and 22, Deeds discloses the apparatus and system of claims 5 and 20 further comprising: an intermediate server (page 5, paragraph 46, server), wherein the communication command (page 4, paragraph 33, on pressing SEND key user initiates communication) and the priority command (page 5, paragraph 42, user is able to prioritize events based on ring tones) may be received from the intermediate server. Deeds does not disclose a position location device such that the position location device generates a location indicator; a transmitter operably coupled to the position location device such that the transmitter transmits the location indicator to an intermediate server, wherein the communication command and the priority command may be received from the intermediate server based on the location indicator.

However, Sandhu et al disclose using a GPS receiver to obtain location information (col 4, lines 25-33, GPS)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Deeds to show a position location device such that the position location device generates a location indicator; a transmitter operably coupled to the position location device such that the transmitter transmits the location indicator to an intermediate server, wherein the communication command and the priority command may be received from the intermediate server based on the location indicator, as taught by Sandhu et al, the motivation being obtaining accurate position information for further calculations (Sandhu et al, col 4, lines

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30-34). Referring to claims 10 and 15, Deeds discloses the method of claims 9 and 14 further comprising: generating a communication command (page 4, paragraph 33, on pressing SEND key user initiates communication). Deeds does not disclose receiving a proximity indicator indicating a location of the recipient device.

However, Sandhu et al disclose using a GPS receiver to obtain location information (col 4, lines 25-33, GPS)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Deeds to show prior to generating the communication command, receiving a proximity indicator indicating a location of the recipient device, as taught by Sandhu et al, the motivation being obtaining accurate position information for further calculations (Sandhu et al, col 4, lines 30-34).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to Generating Alert Commands in Wireless Systems.

U.S. Patent No. 6618600 to Chow et al

U.S. Pat. App. Pub. No. 2001/0005681 to Kim

U.S. Pat. App. Pub. No. 2002/0045466 to Teranishi


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suhail Khan whose telephone number is (703) 305-8730. The examiner can normally be reached on M-F from 7:30 am to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sk



W. R. YOUNG  
PRIMARY EXAMINER